

REMARKS**I. Status Of Claims**

Claims 1-40 are pending.

Claims 1-40 stand rejected.

II. Entry of Prior Amendment and Response

In the instant Office Action, the examiner has failed to explicitly state whether the amendments to the Summary of the Invention, the Abstract and the claims have been entered. Applicant, in order to advance the prosecution of this application, believes that the examiner's silence on this matter indicates an acknowledgement that the amendments made in the response, dated July 23, 2003, have been entered and were sufficient to overcome the examiner's objection to the Summary of the Invention and the Abstract and the rejection of the claims under 35 USC §112.

III. Rejection Under 35 USC §103

The examiner has rejected claims 1-36 and 40 under 35 USC §103(a) as being unpatentable over Landry (USP No. 5,956,700) in view of Mamone (USP No. 4,958,291). It is the examiner's position with regard to independent claims 1 and 19 that Landry "discloses the system and method for processing account information contained in batch files in an on-line manner, said method comprising reading at least one batch file ... (col. 11, lines 64 – col. 12, lines 19); identifying which of said plurality of records relates ... (col. 12, lines 40-65); processing each of said records ... (col. 13, lines 35-60). However, Landry didn't disclose: selecting and restricting access to one of said accounts ... On the other hand, Mamone discloses selecting and restricting access to one of said accounts (col. 5, lines 37-39) removing said restricted access to said selected one of said accounts after all of said records identified as related to said selected one of said accounts are processed (col. 5, lines 37-41). Thus, ... it would have

been obvious ... to include the step selecting and removing said restricted access in the system of Landry as taught by Mamone. The motivation being to enable the users to improve security level to protect the account information when transaction processing."

The examiner has rejected claims 37-39 under 35 USC §103(a) as being unpatentable over Landry in view of Mamone and further in view of Pare Jr. (USP No. 6,154,879). It is the examiner's position that with regard to claims 37-39 "most of the limitations of this claim have been noted in the rejection of claim 19. However, Landry/Mamone didn't disclose: wherein said processor is further operable to: backup said selected ones of said accounts. On the other hand, Pare disclose: wherein said processor is further operable to: backup said selected ones of said accounts (col. 13, lines 25-30). Thus, ... it would have been obvious ... to include step of backup ... in the combination of Landry/Mamone as taught by Pare. The motivation being to improve ultimate recovery by reducing the time and controlling of any errors occur [sic] during the batch process."

Applicant respectfully disagrees with, and explicitly traverses, the examiner's re-stated and new reasons for rejecting the claims. Applicant believes that the present invention is not obvious in view of the references cited by the examiner.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

The references cited, individually or in combination, contrary to the examiner's position, do not teach, disclose, or provide the motivation for one skilled in the art to develop the novel

features of the present invention as suggested by the examiner, as will be shown.

With regard to claim 1, this claim recites:

1. (Previously Amended) A method for processing account information contained in batch process files in an on-line like manner, said method comprising the steps of:
 reading at least one batch file containing a plurality of records, each of said plurality of records being related to and associated with one of a plurality of accounts;
 identifying which of said plurality of records relate to same ones of said plurality of accounts;
 selecting and restricting access to one of said accounts;
 processing each of said records identified as relating to said selected one of said accounts prior to processing any of said records relating to any other of said plurality of accounts; and
 removing said restricted access to said selected one of said accounts after all of said records identified as related to said selected one of said accounts are processed.

Landry discloses a system and method for paying bills without requiring interaction with the payors. "In its simplest form, bill generator 12 may use the Payee Information within the Payee Database 20 as a recurring datafile to search the Payor Information in the Payor Data-base 18 to generate bill records at predetermined times." (see col. 11, lines 64-68). "On some type of recurring basis, either periodically or at operator initiative, bill generator 12 processes generated bill records and transfers them to a TCF message generator 22." (see col. 12, lines 7-10). Hence, the Landry system teaches simply searching of data files in a batch mode.

Mamone discloses a system for accounting for postage expended by postage meter. The system stores the images of an account to be edited in selected regions of non-volatile memory before beginning to edit the account. (see abstract). However, rather than "selecting and restricting access to one of said accounts" as is claimed, access to the accounts is initially restricted and requires a special key, e.g., a supervisor password, to unlock the restricted access to allow a user to update the edited accounts. More specifically, Mamone teaches in col. 7, lines 58-66, "[if] a difference is detected, the system displays the prompt METER DIFFERENCE ...

the system displays the prompt PASSWORD, requesting a supervisory password from the operator, ... the operator may enter the supervisor's password code and the system displays the prompt METER CHANGED." Hence, the system of Mamone operates on restricted files, the postage meter usage files, and requires special permission to allow access. Mamone does not disclose "selecting and restricting access" as the examiner contends.

In the instant case, the examiner believes that the Landry reference combined with the teachings of the Mamone reference would be sufficient to render claim 1 obvious. However, the teachings of Landry and Mamone do not suggest any motivation for combining the references, as suggested by the examiner. Neither the Landry reference, as stated by the examiner, nor the Mamone reference discloses or suggests "selecting and restricting access" as recited in claim 1. In fact, Mamone would never consider such a step as the files that are accessed are already restricted and require a password to allow access.

One skilled in the art would not look to the Mamone reference to find the motivation to modify the Landry reference to develop the novel features of the present invention. Rather, one skilled in the art may review the Landry reference as a first step in learning batch process for bill payment. However, that person would not look to Mamone to select and restrict access to one of the records as claimed because Mamone does not use such a feature.

Furthermore, the examiner states that motivation to combine Landry and Mamone would be to "enable the users to improve security level to protect account information." However, Landry does not suggest security is necessary, while Mamone discloses a system that includes a step for unlocking a restricted file before changes are made to the file. In the present invention, security is not an issue. Rather, the restricted access is for the time that the records of an associated file are being processed. Accordingly, one would again not look to Landry and Mamone to develop the novel features of the present invention.

Having shown that Landry and Mamone do not teach, disclose or provide the motivation for one skilled in the art to develop the novel features of the present invention, applicant submits that the examiner's combination of such references is not justified. Accordingly, the reasons for rejecting the claims are not sustainable.

Applicant wishes to thank the examiner for providing reference to specific statements in each of the cited references that the examiner believes support rendering the claimed subject matter obvious. However, applicant submits that in the matter of obviousness there is a great emphasis placed on "the importance of the motivation to combine." Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc., 231 F. 3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000).

More specifically, in the matter of obviousness, the court found that:

"an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *id.* quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)"

In this case, applicant submits that the instant invention as recited in claim 1 is not obvious in view of the cited references as neither reference provides motivation to combine the teachings as suggested by the examiner. Furthermore, even if the references were combined in some manner, the combined teachings would not, as shown above, include each of the steps of the instant invention.

Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of claim 1.

With regard to independent claim 19, the examiner rejected this claim citing the same references used in rejecting claim 1. Thus applicant's remarks made in response to claim 1 are repeated with regard to claim 19. Accordingly, applicant submits that in view of the remarks made with regard to the rejection of claim 1, which are repeated herein in response to the rejection of claim 19, the examiner's rejection of claim 19 can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of claim 19.

The examiner has rejected each of the dependent claims based on a rejection of the independent claim from which they depend. Accordingly, the applicant's remarks made in response to claims 1 and 19 are also applicable in response to the rejection of each of the dependent claims 2-18 and 20-36 and 40. In view of the remarks made with regard to the rejection of claims 1 and 19, which are repeated herein in response to the rejection of the dependent claims, applicant respectfully submits that the examiner's rejection of the dependent claims can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of each of the dependent claims.

With regard to claims 37-39, these claims also depend from claim 19. Accordingly, the applicant's remarks made in response to claim 19 are also applicable in response to the rejection of each of the dependent claims 37-39. In view of the remarks made with regard to the rejection of claim 19, which are repeated herein in response to the rejection of the dependent claims, applicant respectfully submits that the examiner's rejection of the dependent claims can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of each of the dependent claims.

Applicant submits that the reasons for the examiner's rejection of the claims have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

IV. Conclusion

Having addressed the examiner's objections to the specification and rejection of the claims under 35 USC §103, applicant submits that the reasons for the examiner's rejection have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the objection and rejection and that a Notice of Allowance regarding claims 1-40 be issued.

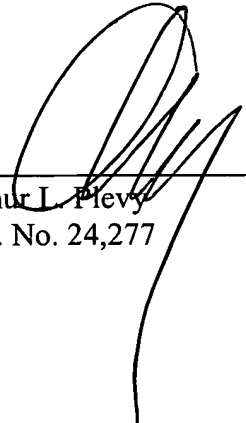
If the examiner believes that the prosecution of this matter may be advanced by a telephone call, the examiner is invited to contact applicant's attorney at the telephone number indicated below.

V. Fees

No fees are believed necessary for filing this election and response. However, the Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to Duane Morris LLP deposit account 50-2061.

Respectfully submitted,

Dated: 11/11/03



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